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| APPLICATION NO.              | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/575,132                   | 05/23/2000  | Kia Silverbrook      | NPA005US            | 9161             |
| 24011                        | 7590        | 08/01/2005           | EXAMINER            |                  |
| SILVERBROOK RESEARCH PTY LTD |             |                      | LE, KHANH H         |                  |
| 393 DARLING STREET           |             |                      | ART UNIT            |                  |
| BALMAIN, 2041                |             |                      | PAPER NUMBER        |                  |
| AUSTRALIA                    |             |                      | 3622                |                  |

DATE MAILED: 08/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/575,132

**Applicant(s)**

SILVERBROOK ET AL.

**Examiner**

Khanh H. Le

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 4-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-2, 4-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 10/21/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. This Office Action is in response to Applicants' "Amendment C" dated 3/21/2005.

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3/21/05 has been entered.

Amendment of the Specifications and of claim 1 has been entered. Claims 1-2, 4-28 are now pending. Claims 1,14 are independent.

### **Response to Arguments**

2. Applicant's arguments have been fully considered but they are not persuasive.

In response to applicant's arguments at page 7 last paragraph to page 8, 4<sup>th</sup> full paragraph, that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., interpretation of signals from the sensing device; responsiveness for individual user tailored documents; positions of the user interactive elements varying between different versions of the personalized documents; position of the coded data not being fixed; the information from the interactive elements has to correspond to the different formats for different users; distinguishing between the formatting of the documents ; format used stored as a page description allowing the position etc. ) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

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Further, all the features argued at pages 10, 1<sup>st</sup>, 3<sup>rd</sup>, and 4<sup>th</sup> full paragraphs as well at page 11, 2<sup>nd</sup>-4<sup>th</sup> full paragraphs are not claimed.

In response to most of Applicants' arguments, the references applied can perform all the functions actually claimed.

Claim1 basically claims :

- 1) receiving by a printer information formatted according to stored user preferences
- 2) the information include some user targeted content
- 3) the printer prints the document with some user interactive elements which enable the user to request further information regarding the (targeted) content.

The references are applied as follows:

- 1) INTELLIGENT PAPER discloses targeted printed catalogs with interactive elements as claimed.
- 2) it is known and admitted some catalogs are printed according to user preferences and demographics that are implicitly stored on some computer system.
- 3) it is known user demographics and preferences can be captured by monitoring user interaction with webpages .

Rejection of the claims properly was made, from a combination of the references and well known facts above, coupled with the following motivation as stated earlier:

"Since the intelligent paper works as a webpage ( (see at least "INTELLIGENT PAPER" page 2, 2<sup>nd</sup> full paragraph, paper = touch sensitive screen...) and capture of user data such as demographics and preferences from interaction with WebPages, for content targeting and document formatting, functionalities are well-known , it would have been obvious to one skilled in the art at the time the invention was made to add these well-known functionalities to the Intelligent Paper Product Catalog system .. to make the catalogs more appealing to the consumers."

In other words, once user demographics and preferences are captured from user interaction with INTELLIGENT PAPER, it would have been obvious to use that data to “make the catalogs more appealing to the consumers”. The motivation to combine is perfectly proper and is derived from one of the well-known or admitted fact. It does not have to derive from INTELLIGENT PAPER as argued.

Applicants essentially reiterate the earlier challenge that there isn't motivation to combine Intelligent Paper and such admittedly known marketing techniques because there is no disclosure or suggestion in the prior art of a system that could possibly support the functionalities that may be disclosed in the instant application. However, those specific functionalities that Applicants argue about are not claimed. For example the functionality of “positions of the user interactive elements varying between different versions of the personalized documents” is not claimed and nothing in the claims require the references as applied to meet that functionality in order for the rejections to be proper.

A catalog made of intelligent paper which has interactive elements on it, and which has targeted and formatted content on it and the implicit system (printers, sensors, computers, servers, databases) which allow production of such catalog and the interactions therewith, meet all the functionalities required by the present claims.

The following is essentially a repeat of the earlier Office Action as the prior art as previously applied discloses amended claim 1 as well. Responses to Arguments presented in the last Office Action are still relevant and are herein included *italics*.

***Response to Arguments (Previous Office Action)***

3. *Applicants admit the user preference formatting and targeting of information are well-known marketing methods with conventional communication media (Response at page 14).*

*Applicants however essentially dispute that there isn't motivation to combine Intelligent Paper and such admittedly known marketing techniques because "there is simply no disclosure or suggestion in the prior art of a system that could possibly support that functionality (Response at page 13).*

*This is not persuasive. Intelligent Paper discloses Product Catalogs that are implicitly targeted to a particular customer (p. 401, 1<sup>st</sup> full paragraph": "the user's address and ordering record is known at the time the pointer is clicked over an item" implies the demographics of the consumer are known and stored on some system computer.)*

*Since the "Intelligent Paper" targeted Product Catalogs are a marketing tool, it would have been obvious to use such admittedly known marketing techniques as user preference formatting and targeting of information in the "Intelligent Paper" targeted Product Catalogs to make the catalogs more appealing to the consumers .*

*Since the intelligent paper works as a webpage ( (see at least "INTELLIGENT PAPER" page 2, 2<sup>nd</sup> full paragraph, paper = touch sensitive screen...) and capture of user data such as demographics and preferences from interaction with WebPages, for content targeting and document formatting, functionalities are well-known , it would have been obvious to one skilled in the art at the time the invention was made to add these well-known functionalities to the Intelligent Paper Product Catalog system (contrary to arguments , at page 13, 6<sup>th</sup> full paragraph), to make the catalogs more appealing to the consumers .*

*The Examiner notes that none of the Official Notices taken in the last Office Action were challenged and thus taken as admitted. MPEP 2144.03.*

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4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. **Claims 1-2, 4-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over "Intelligent Paper" by M. Dymetman, and Max Copperman, in Electronic Publishing, Artistic Imaging and Digital Typography, Proceedings of EP '98, March/April 1998, Springer Verlag LNCS 1375, pp 392-406.**

As to claim 1, "Intelligent Paper" discloses Interactive paper, a method for providing content in a document, including:

the document having at least one user interactive element which enables the user to indicate a request for further information relating to the content by interacting with the element using a sensing device which is adapted to transmit data indicating the request to a computer system. (see at least pages 392-393) .

As to" providing targeted content in a document, including:

providing a user with a printed document, formatted to include information with content targeted to demographics of the user", Intelligent Paper discloses Product Catalogs that are provided with users' addresses thus it is interpreted the catalogs are targeted to the user's demographics (address) ( p. 401, 1<sup>st</sup> full paragraph": "the user's address ").

Further, Official Notice was earlier taken that providing targeted content in a document, including:

providing a user with a printed document, formatted to include information with content targeted to demographics of the user, is well-known. (previous Office Action, page 3, 1<sup>st</sup> full paragraph).

Also, as to the document provided being formatted according to user preferences (old claim 3, now in claim 1), Official Notice was earlier taken that such marketing methods are well-known (previous Office Action, page 3, 4<sup>th</sup> and 5<sup>th</sup> full paragraphs).

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These Official Notices were not challenged thus taken as admitted. MPEP 2144.03. Further, Applicants admit the user preference formatting and targeting of information are well-known marketing methods with conventional communication media (Applicants' Response at page 14).

Since the "Intelligent Paper" targeted Product Catalogs are a marketing tool, it would have been obvious to one skilled in the art at the time the invention was made to use the admittedly known marketing techniques of user preferences formatting and targeting of information in the "Intelligent Paper" targeted Product Catalogs to make the catalogs more appealing to the consumers.

As to the printer in the preamble, it is implicit a printer is used to print the intelligent catalogs.

As to Claim 2, "Intelligent Paper" discloses sending information after request from a user over a computing system (see at least p.1-2) .

As to Claims 4 and 5, Official Notice was taken that wherein the targeted content comprises advertising material and

wherein the at least one interactive element is provided in association with the advertising material and the further information is provided in the form of a printed product brochure

are well-known marketing methods and it would have been obvious to one skilled in the art at the time of the invention to incorporate those well-known marketing methods into the teachings of "Intelligent Paper" to effect the advertising goals.



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(Further, the Examiner now notes , as to Claim 4 , Intelligent Paper discloses wherein the targeted content comprises advertising material (targeted Product Catalogs ) ( p. 401, 1<sup>st</sup> full paragraph”: “the user’s address “).

Also as to Claim 5, Intelligent Paper discloses  
wherein the at least one interactive element is provided in association with the advertising material (Intelligent Paper as printed product catalog with catalog items being interactive)).

As to claims 6-12: “Intelligent Paper” discloses

Claim 6. the document includes coded data indicative of an identity of the document ( “INTELLIGENT PAPER” page 392, code page-id) and of the at least one interactive element (“INTELLIGENT PAPER” page 392, pointer-loc) ,

and wherein the method includes

receiving, in the computer system, indicating data from the sensing device regarding the identity of the document and a position of the sensing device relative to the document in order to identify the document and determine when the sensing device is used to interact with the element (“INTELLIGENT PAPER” page 392, pair: code page-id, pointer-loc).

Claim 7 (dependent on claim 6).

“INTELLIGENT PAPER” further discloses

receiving, in the computer system, movement data regarding movement of the sensing device relative to the document (see e.g., “INTELLIGENT PAPER” page 393, 1<sup>st</sup> full paragraph: “position over the Louvre”).

Claim 8.(dependent on claim 7).

“INTELLIGENT PAPER” further discloses the sensing device sensing its movement relative to the document using at least some of the coded data, and identifying the request in the computer system from the movement being at least partially within a zone associated with the interactive element (see e.g., “INTELLIGENT PAPER” page 393, 1<sup>st</sup> full paragraph: “position over the Louvre”).

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Claim 9.

Providing the sensing device with an identification code specific to a particular user and the method including monitoring use of the sensing device in the computer system ("Intelligent Paper", page 401, product catalogues).

Claim 10 (dependent on claim 6).

"Intelligent Paper" further discloses "printing the document on a surface of a surface-defining

structure (interpreted as a paper) and at the same time, printing the coded data on the surface ("Intelligent Paper", page 392-393, last paragraph, and Fig. 2, p. 396.)

Claim 11 (dependent on claim 6).

"Intelligent Paper" further discloses printing the coded data to be substantially invisible in the visible spectrum ("Intelligent Paper", page 393, last paragraph.)

Claim 12 (dependent on claim 6).

"Intelligent Paper" further discloses retaining a retrievable record of the printed document, the document being retrievable using the identity data as contained in the coded data ("page-id").

As to claim 13, binding pages if the document is printed on multiple pages is known and it would have been obvious to one skilled in the art at the time of the invention to add such binding if the document is more than one page. (see e.g. "Intelligent Paper", page 401, product catalogues).

Claims 14, 15, 16, 19, 20, 21, 22 substantially parallel the limitations of claims 1, 4, 3, 6, 7, 8 and 9, respectively, in system format and are rejected on the same basis.

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As to claims 17-18, using an advertising server for providing the advertising material to the publication server and using a registration server where demographic data of the user is stored for access by the publication server, in order to allow the advertising material to be demographically targeted are well-known marketing methods; thus it would have been obvious to one skilled in the art at the time of the invention to add those well-known methods in the teachings of "INTELLIGENT PAPER" to effect targeted marketing.

Claim 23. (dependent on claim 14)

"Intelligent Paper" discloses the sensing device includes a marking nib. (see, "Intelligent Paper", Fig. 1 at least).

Claims 24-26 substantially parallel the limitations of claims 10-11 respectively, in system format and are rejected on the same basis.

Claims 27-28 substantially parallel the limitations of claims 12-13 respectively, in system format and are rejected on the same basis.

### **Conclusion**

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khanh H. Le whose telephone number is 571-272-6721. The Examiner works a part-time schedule and can normally be reached on Tuesday-Wednesday 9:00-6:00.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The fax phone numbers for the organization where this application or proceeding is assigned are **571-273-8300** for regular communications and for After Final communications. Any inquiry of a general nature or relating

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to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-3600. Hand carry deliveries must be made to the Customer Service Window (now located at the Randolph Building, 401 Dulany Street, Alexandria, VA 22314).

Khanh H. Le

July 25, 2005

*KHL*



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SUPERVISORY PATENT EXAMINER  
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